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**Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/268,412 03/15/99 SILVERA

A 31045-7

EXAMINER

QM32/0413

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MOHANDESI, J

ART UNIT

PAPER NUMBER

3728

DATE MAILED:

04/13/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/268,412**

Applicant(s)

**Silvera**

Examiner

**Jila Mohandesi**

Group Art Unit

**3728**



☒ Responsive to communication(s) filed on Feb 22, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1, 2, and 4-20 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1, 2, and 4-20 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3728

### DETAILED ACTION

1. The examiner will treat references in the application to stick-on tattoos as relating merely to adhesive-backed prints or stickers having decorative designs and/or legends which are commonly adapted to be placed on a toy, child or apparel.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 5, 7, 8-10 and 11 are rejected under 35 U.S.C. 103(a) as being obvious over Lehmann et al. (5,421,765) in view of Vidinic (5,290,043). Lehmann '765 teaches substantially all the limitations of the claims such as stimulated tattoos/stickers **32** comprising a front image surface **32a** which carries the visible design of the stimulated tattoos/stickers, and an adhesive backing means **32b** adapted to be removably secured to different parts of either or both a toy element means **12** and or a child. The back of the stimulated tattoos/stickers are moistened and then placed on and/or removed from the hair or the surface or clothing of the toy element means **12** or the child. Lehmann '756 does not appear to specifically teach providing stimulated tattoos/stickers on different parts of the shoe. Providing stimulated tattoos/stickers on different parts of the shoe, is so old and

Art Unit: 3728

conventional as to hardly require citation of a reference, but Vidinic '043 is provided merely as an example of this common practice. Therefore, it would have been obvious to one having ordinary skill in the art and in view of Vidinic '043 to provide stimulated tattoos/stickers on shoes to decorate them as one pleases. With respect to claims 2 and 9 which further limits the material of the stimulated tattoos/stickers, it would have been obvious to one having ordinary skill in the art to modify and/or alter the shape and material of stimulated tattoos/stickers to provide different designs and/or as an obvious choice of design or as a matter of routine optimization since it would appear they would work equally well in any of a variety of sizes, shapes or materials. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

4. Claims 1-2 and 4-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lehmann et al. (5,421,765) in view of Kellin et al. (5,136,726). Lehmann '765 substantially teaches all the limitations of the claims such as stimulated tattoos/stickers **32** comprising a front image surface **32a** which carries the visible design of the stimulated tattoo, and an adhesive backing means **32b** adapted to be removably secured to different parts of either or both a toy element means **12** and a child. The back of the stimulated tattoos/stickers are moistened and then placed on and/or removed from the hair or the surface or clothing of the toy element means **12** or the child. Lehmann '765 does not appear to teach placing stimulated tattoos/stickers on shoes. Kellin '726 teaches placing one or more of detachable decorative elements on different articles of apparel such as boots, shoes, cap, belt and backpacks as shown in Figures 1,2, 6, 8 and 9 embodiments. Therefore, it would have been

Art Unit: 3728

obvious to one having ordinary skill in the art and in view of Kellin '726 to provide stimulated tattoos/stickers to different apparels such a boots, shoes and caps. With respect to claims 4, 6-7 which further limit the shape, size make of the shoes and location on the shoe the stimulated tattoos/stickers is placed, this would be entirely a design choice depending on the type, shape, size of the shoe and the users choice as where to place the tattoo on the shoes. With respect to claims 2 and 9 which further limits the material of the stimulated tattoos/stickers, it would have been obvious to one having ordinary skill in the art to modify and/or alter the shape and material of stimulated tattoos/stickers to provide different designs and/or as an obvious choice of design or as a matter of routine optimization since it would appear they would work equally well in any of a variety of sizes, shapes or materials. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

*In re Leshin*, 125 USPQ 416.

5. Claim 12-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Penataro (764,103) in view of Lehmann et al. (5,421,765). Penataro '103 teaches placing an ornamental strip in a recess with a smooth surface on a shoe. Penataro '103 does not appear to teach the ornamental strip to be a stick-on stimulated tattoos/stickers. Lehmann '765 teaches stick-on stimulated tattoos/stickers 32 with an adhesive backing means 32b adapted to be removably secured to different parts of either or both a toy element means 12 and a child. Therefore, it would have been obvious to one having ordinary skill in the art and in view of Lehmann '765 to provide stimulated tattoos/stickers in the recess area of Penataro '103 shoe as an aesthetic choice. With respect to

Art Unit: 3728

claims 13-14 and 17 which further limit the shape, size of the recess portion and smooth portion, it would have been obvious to one having ordinary skill in the art to modify and/or alter the shape and size of the recess portion and smooth portion in order to fit the decorative strip more securely and/or as an obvious choice of design or as a matter of routine optimization since it would appear they would work equally well in any of a variety of sizes or shapes. With respect to claims 15-16 and 19 which further limit the material of smooth portion and stimulated tattoos/stickers, it would have been obvious to one having ordinary skill in the art to modify and/or alter the material of the smooth portion and the stimulated tattoos/stickers depending on their intended use and for ease of manufacturing and cost and/or as an obvious choice of design or as a matter of routine optimization since it would appear they would work equally well in any of a variety of materials. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. With respect to claim 18, whether the smooth portion is stiched into the outer portion of the shoe or any other art recognized equivalent is an obvious matter of choice, such as easier and cheaper manufacturing.

### ***Response to Arguments***

6. Applicant's arguments filed February 22, 2000 have been fully considered but they are not persuasive. It is difficult to know how to respond to arguments denying the undeniable i.e. that shoes are not smooth, white/clear or made of PVC. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be

Art Unit: 3728

established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Kellin '726 teaches placing one or more of detachable decorative elements on different articles of apparel such as boots, shoes, cap, belt and backpacks as shown in Figures 1, 2, 6, 8 and 9 embodiments. Therefore, it would have been obvious to one having ordinary skill in the art and in view of Kellin '726 to provide the stimulated tattoos/stickers of Lehmann '765 to different apparels such a boots, shoes and caps. In response to applicant's argument that stick-on tattoos adhere better to smooth surfaces, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the

Art Unit: 3728

mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is cited on PTO-892 enclosed herewith.

9. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Ebony Smith at (703)305-3570.

For applicant's convenience, the Group Technological Center FAX number is (703) 305-3579. Please identify Examiner \_\_\_\_\_ of Art Unit \_\_\_\_\_ at the top of your cover sheet of any correspondence submitted.

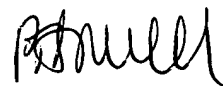


Application/Control Number: 09/268,412

Page 8

Art Unit: 3728

Inquiries concerning the merits of the examination should be directed to Jila Mohandesi whose telephone number is (703) 305-7015.



Paul T. Sowell  
Supervisory Patent Examiner  
Group 3700

JMM

April 7, 2000